

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Reissue Application	)	
of U. S. Patent No. 6,342,590	)	
	)	
Applicants: Shigeo Morimoto et al.	)	Group Art Unit:
	)	TBA
Granted: January 29, 2002	)	
	)	
Reissue Serial Number:	)	
TBA	)	
	)	Examiner:
For: Erythromycin A Derivatives and	)	TBA
Method for Preparing Same	)	

**REISSUE DECLARATION UNDER  
37 C.F.R. §1.175 AND POWER OF ATTORNEY**

Box REISSUE  
Assistant Commissioner for Patents  
Washington, DC 20231

Sir:

We hereby declare that:

1. Our residence, post office address, and citizenship are as stated below next to our names.
2. We believe that we are the original, first and sole inventors of the subject matter described and claimed in U.S. Patent No. 6,342,590 (original patent) granted on January 29, 2002, and for which a reissue patent is sought on the invention entitled: ERYTHROMYCIN A DERIVATIVES AND METHOD FOR PREPARING SAME, the specification of which:

☒ is attached hereto.

☐ was filed on \_\_\_\_\_ as reissue application no. \_\_\_\_\_ and was amended on \_\_\_\_\_.

3. We do not know and do not believe that this invention was ever known or used in the United States before our invention thereof; and to the best of our knowledge and belief, said invention was not in public use or on sale in the United States more than one (1) year prior to our application or patented or made the subject of an inventor's certificate or described in any printed publication in any country before our invention or more than one (1) year prior to our application or patented in any foreign country.

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COUNTRY (if PCT, indicate "PCT")	APPLICATION NUMBER	DATE OF FILING (day, month, year)	PRIORITY CLAIMED UNDER 35 USC 119	
Japan	2-220315	18 September, 1986	<input checked="" type="checkbox"/> YES	NO
			YES	NO
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			YES	NO
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<b>Send Correspondence to:</b> <b>Customer Number 23723</b>  <b>Attention: IP Docketing</b> <b>Patterson, Belknap, Webb &amp; Tyler, LLP</b> <b>1133 Avenue of the Americas</b> <b>New York, New York 10036</b>			<b>Direct Telephone Calls to:</b> <small>(name and telephone number)</small>  <b>Stuart E. Pollack</b> <b>(212) 336-2721</b>
<b>FULL NAME OF INVENTOR</b>	<b>FAMILY NAME</b> <b>MORIMOTO</b>	<b>FIRST GIVEN NAME</b> <b>Shigeo</b>	<b>SECOND GIVEN NAME</b>
<b>INVENTOR'S SIGNATURE</b>	<i>Shigeo Morimoto</i>	<b>DATE</b>	<b>January 27, 2004</b>
<b>RESIDENCE &amp; CITIZENSHIP</b>	<b>CITY</b> <b>Saitama</b>	<b>STATE OR FOREIGN COUNTRY</b> <b>Japan</b>	<b>COUNTRY OF CITIZENSHIP</b> <b>Japan</b>
<b>POST OFFICE ADDRESS</b>	<b>POST OFFICE ADDRESS</b> 1-16-21, Hiranuma, Yoshikawa-shi	<b>CITY</b> <b>Saitama</b>	<b>STATE &amp; ZIP CODE/COUNTRY</b> <b>/Japan 342-0056</b>

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<b>FULL NAME OF INVENTOR</b>	<b>FAMILY NAME</b> <b>ADACHI</b>	<b>FIRST GIVEN NAME</b> <b>Takashi</b>	<b>SECOND GIVEN NAME</b>
<b>INVENTOR'S SIGNATURE</b>	<i>Takashi Adachi</i>	<b>DATE</b>	<b>January 27, 2004</b>
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<b>POST OFFICE ADDRESS</b>	<b>POST OFFICE ADDRESS</b> 4-2-1-12-203, Sakurada, Washimaya-cho	<b>CITY</b> Kitakatsushika-gun, Saitama	<b>STATE &amp; ZIP CODE/COUNTRY</b> <b>/Japan 340-0203</b>

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FULL NAME OF INVENTOR	FAMILY NAME MATSUNAGA	FIRST GIVEN NAME Tohru	SECOND GIVEN NAME
INVENTOR'S SIGNATURE	<i>Tohru Matsunaga</i>	DATE	January <u>27</u> , 2004
RESIDENCE & CITIZENSHIP	CITY Saitama	STATE OR FOREIGN COUNTRY Japan	COUNTRY OF CITIZENSHIP Japan
POST OFFICE ADDRESS	POST OFFICE ADDRESS 846-5 [2-121], Koguki, Kuki-shi	CITY Saitama	STATE & ZIP CODE/COUNTRY /Japan 346-0001

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POST OFFICE ADDRESS	POST OFFICE ADDRESS 1360, Horisaki-cho, Minuma-ku	CITY <b>Saitama-shi, Saitama</b>	STATE & ZIP CODE/COUNTRY <b>/Japan 337-0052</b>

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2. We believe that we are the original, first and sole inventors of the subject matter described and claimed in U.S. Patent No. 6,342,590 (original patent) granted on January 29, 2002, and for which a reissue patent is sought on the invention entitled: ERYTHROMYCIN A DERIVATIVES AND METHOD FOR PREPARING SAME, the specification of which:

☒ is attached hereto.

☐ was filed on \_\_\_\_\_ as reissue application no. \_\_\_\_\_ and was amended on \_\_\_\_\_.

3. We do not know and do not believe that this invention was ever known or used in the United States before our invention thereof; and to the best of our knowledge and belief, said invention was not in public use or on sale in the United States more than one (1) year prior to our application or patented or made the subject of an inventor's certificate or described in any printed publication in any country before our invention or more than one (1) year prior to our application or patented in any foreign country.

4. We have reviewed and understand the contents of the specification and claims of the reissue application as amended by a Preliminary Amendment.

5. We hereby claim foreign priority benefits under Title 35, United States Code, §119 of any foreign application(s) for patent or inventor's certificate or of any PCT international application(s) designating at least one country other than the United States of America listed below and have also identified below any foreign application(s) for patent or inventor's certificate or any PCT international application(s) designating at least one country other than the United States of America filed by me on the same subject matter having a filing date before that of the application(s) of which priority is claimed:

PRIOR FOREIGN/PCT APPLICATION(S) AND ANY PRIORITY CLAIMS UNDER 35 U.S.C. 119:				
COUNTRY (if PCT, indicate "PCT")	APPLICATION NUMBER	DATE OF FILING (day, month, year)	PRIORITY CLAIMED UNDER 35 USC 119	
Japan	2-220315	18 September, 1986	<input checked="" type="checkbox"/> YES	NO
			YES	NO
			YES	NO
			YES	NO
			YES	NO

6. We acknowledge the duty to disclose all information to the United States Patent Office known to us to be material to the examination of the reissue application, in accordance with 37 C.F.R. § 1.56.

7. We believe the original patent, upon which the reissue application is based, is partly inoperative by reason of our having claimed less than we had a right to claim therein, in that we had a right to claim our invention more specifically; and more particularly by us having omitted therefrom narrower claims than the scope of the original and sole patent claim 1.

8. The invention disclosed in the original patent included methods for making 6-O-methylerythromycin from Erythromycin A-9-oxime, and even more broadly, intermediate steps used in the synthesis of 6-O-methylerythromycin from Erythromycin A. It also included novel intermediate products used in the preparation of 6-O-methylerythromycin.

9. Claim 1, the sole claim of the original patent, claimed certain novel intermediate steps that may be used in the synthesis of 6-O-methylerythromycin, or any other similar compound, starting from Erythromycin A-9-oxime. Further steps required to obtain the typically-desired final compound—6-O-methylerythromycin—are described in detail, including without limitation in column 4, line 48 through column 5, line 30. Specific examples—Referential Examples 1 and 2—are provided in column 10, line 52 through column 11, line 53.

10. The new process claims proposed in the Preliminary Amendment are narrower in scope than claim 1, and cover only those processes that lead to 6-O-methylerythromycin, including the additional steps required to convert the novel intermediate into 6-O-methylerythromycin.

11. The particular features of our invention as set forth in claims 2-5 are narrower in scope than the existing claim 1 of the original patent. In order to provide the

complete range of protection to which we are entitled, and which we had desired to obtain in our original application that matured into U.S. Patent No. 6,342,592, it is desirable to have claims of the scope of claims 2-5.

12. We understand that new claims 2-5 might provide better protection against infringers that may practice these claims abroad. Our attorneys have advised us that under the law, claims 2-5 are narrower in scope than original claim 1. Nevertheless, to the extent claims 2-5 are deemed by the examiner to be broader than original claim 1, and in order to provide the complete range of protection to which we are entitled, and which we had desired to obtain in our original application that matured into U.S. Patent No. 6,342,592, we desire to broaden our claims to have the scope of claims 2-5.

8. The error of claiming less than we had a right to claim arose without deceptive intent on our part.

9. In view of the foregoing, U.S. Patent No. 6,342,590 should be reissued with the claims now presented or with claims commensurate therewith.

10. Wherefore, the undersigned request a reissue patent as herein sought for the purpose of adequately, clearly, and fully protecting the disclosed invention to which we are entitled.

13. We hereby appoint Practitioners at Customer Number 23723, Patterson, Belknap, Webb & Tyler LLP, as my/our attorney(s) or agent(s) to prosecute the application identified above, and to transact all business in the United States Patent and Trademark Office connected therewith.

14. We hereby declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and



further, that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued therein.

<b>Send Correspondence to:</b> <b>Customer Number 23723</b>  Attention: IP Docketing Patterson, Belknap, Webb & Tyler, LLP 1133 Avenue of the Americas New York, New York 10036			<b>Direct Telephone Calls to:</b> <small>(name and telephone number)</small>  Stuart E. Pollack (212) 336-2721
FULL NAME OF INVENTOR	FAMILY NAME WATANABE	FIRST GIVEN NAME Yoshiaki	SECOND GIVEN NAME
INVENTOR'S SIGNATURE <i>Yoshiaki Watanabe</i>	DATE		January <u>27</u> , 2004
RESIDENCE & CITIZENSHIP	CITY Aomori	STATE OR FOREIGN COUNTRY Japan	COUNTRY OF CITIZENSHIP Japan
POST OFFICE ADDRESS	POST OFFICE ADDRESS 73-1, Sainokami, Imadzu, Tairadate-mura	CITY Higashitsugaru-gun, Aomori	STATE & ZIP CODE/COUNTRY /Japan <b>030-1413</b>

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Reissue Application	)	
of U. S. Patent No. 6,342,590	)	
	)	
Applicants: Shigeo Morimoto et al.	)	Group Art Unit:
	)	TBA
Granted: January 29, 2002	)	
	)	
Reissue Serial Number:	)	
TBA	)	
	)	Examiner:
For: Erythromycin A Derivatives and	)	TBA
Method for Preparing Same	)	

**REISSUE DECLARATION UNDER  
37 C.F.R. §1.175 AND POWER OF ATTORNEY**

Box REISSUE  
Assistant Commissioner for Patents  
Washington, DC 20231

Sir:

We hereby declare that:

1. Our residence, post office address, and citizenship are as stated below next to our names.
2. We believe that we are the original, first and sole inventors of the subject matter described and claimed in U.S. Patent No. 6,342,590 (original patent) granted on January 29, 2002, and for which a reissue patent is sought on the invention entitled: ERYTHROMYCIN A DERIVATIVES AND METHOD FOR PREPARING SAME, the specification of which:

☒ is attached hereto.

☐ was filed on \_\_\_\_\_ as reissue application no. \_\_\_\_\_ and was amended on \_\_\_\_\_.

3. We do not know and do not believe that this invention was ever known or used in the United States before our invention thereof; and to the best of our knowledge and belief, said invention was not in public use or on sale in the United States more than one (1) year prior to our application or patented or made the subject of an inventor's certificate or described in any printed publication in any country before our invention or more than one (1) year prior to our application or patented in any foreign country.

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COUNTRY (if PCT, indicate "PCT")	APPLICATION NUMBER	DATE OF FILING (day, month, year)	PRIORITY CLAIMED UNDER 35 USC 119	
Japan	2-220315	18 September, 1986	<input checked="" type="checkbox"/> YES	NO
			YES	NO
			YES	NO
			YES	NO
			YES	NO

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14. We hereby declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and

further, that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued therein.

<b>Send Correspondence to:</b> <b>Customer Number 23723</b>  Attention: IP Docketing Patterson, Belknap, Webb & Tyler, LLP 1133 Avenue of the Americas New York, New York 10036			<b>Direct Telephone Calls to:</b> <small>(name and telephone number)</small>  Stuart E. Pollack (212) 336-2721
FULL NAME OF INVENTOR	FAMILY NAME SOTA	FIRST GIVEN NAME Kaoru	SECOND GIVEN NAME
INVENTOR'S SIGNATURE <i>Kaoru Sota</i>	DATE	January <u>27</u> , 2004	
RESIDENCE & CITIZENSHIP	CITY Saitama	STATE OR FOREIGN COUNTRY Japan	COUNTRY OF CITIZENSHIP Japan
POST OFFICE ADDRESS	POST OFFICE ADDRESS 1158-11, Shimotomi, Tokorozawa	CITY Saitama	STATE & ZIP CODE/COUNTRY /Japan 359-0001

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**POWER OF ATTORNEY  
and  
CORRESPONDENCE ADDRESS  
INDICATION FORM**

Application Number	Not yet assigned—Reissue of 6,342,590 B1
Filing Date	January 28, 2004
First Named Inventor	Morimoto
Title	Erythromycin A Derivatives and Method for Preparing Same
Art Unit	Not yet assigned
Examiner Name	Not yet assigned
Attorney Docket Number	A0407-001592A

I hereby appoint:

☒ Practitioners associated with the Customer Number:

23723

OR

☐ Practitioner(s) named below:

Name	Registration Number

as my/our attorney(s) or agent(s) to prosecute the application identified above, and to transact all business in the United States Patent and Trademark Office connected therewith.

Please recognize or change the correspondence address for the above-identified application to:

☒ The address associated with the above-mentioned Customer Number:

OR

☐ The address associated with Customer Number:

OR

☐ Firm or Individual Name

Address

Address

City

State

Zip

Country

Telephone

Fax

I am the:

☐ Applicant/Inventor.☒ Assignee of record of the entire interest. See 37 CFR 3.71.  
Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)**SIGNATURE of Applicant or Assignee of Record**

Name Akira Uehara, President, Taisho Pharmaceutical Company, Ltd.

Signature 

Date 27 January, 2004

Telephone 011-81-03-3985-1111

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

☐ \*Total of \_\_\_\_\_ forms are submitted.

This collection of information is required by 37 CFR 1.31 and 1.33. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 3 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

EL625996883US

EXPRESS MAIL LABEL NO.: ~~EX625996883US~~

ATTORNEY DOCKET NO.: A0407-001592A

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Reissue Application	)	
of U. S. Patent No. 6,342,590	)	
Applicants: Shigeo Morimoto et al.	)	Group Art Unit:
	)	TBA
Granted: January 29, 2002	)	
Reissue Serial Number:	)	
TBA	)	
For: Erythromycin A Derivatives and	)	Examiner:
Method for Preparing Same	)	TBA

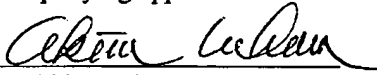
**ASSENT OF ASSIGNEE TO REISSUE**

Box REISSUE  
Assistant Commissioner for Patents  
Washington, DC 20231

Sir:

The undersigned, by authority vested in him by Taisho Pharmaceutical Company, Limited, assignee of the entire interest in U.S. Patent No. 6,342,590, the invention described therein, and in any reissue thereof by assignment recorded at Reel 4770, Frame 0623, hereby assents on behalf of the assignee to the accompanying application for reissue.

Date: 27 January, 2004

By:   
Akira Uehara  
President  
Taisho Pharmaceutical Company, Limited  
24-1, Takata 3-Chome  
Toshimaku  
Tokyo 170-8833  
Japan



EL625996883US

EXPRESS MAIL LABEL NO.: ~~EL625996883US~~

ATTORNEY DOCKET NO.: A0407-001592A

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Reissue Application	)	
of U. S. Patent No. 6,342,590	)	
	)	
Applicants: Shigeo Morimoto et al.	)	Group Art Unit:
	)	TBA
Granted: January 29, 2002	)	
	)	
Reissue Serial Number:	)	
TBA	)	
	)	Examiner:
For: Erythromycin A Derivatives and	)	TBA
Method for Preparing Same	)	

**CERTIFICATE UNDER 37 C.F.R. 3.73(b)**

Box REISSUE  
Assistant Commissioner for Patents  
Washington, DC 20231

Sir:

Taisho Pharmaceutical Company, Limited, a corporation in Tokyo, Japan,  
certifies that it is the assignee of the entire interest in U.S. Patent No. 6,342,590, by virtue of the  
chain of title from the inventor to the assignee as shown below:

FROM	TO	REEL/FRAME NO. or Documents Enclosed
Shigeo Morimoto Takashi Adachi Tohru Matsunaga Masato Kashimura Yoshiaki Watanabe Kaoru Sota	Taisho Pharmaceutical Company, Ltd.	4770/0623

The undersigned (whose title is supplied below) is empowered to sign this  
certificate on behalf of the assignee.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further, that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued therein.

Respectfully submitted,

Date: 27 January, 2004

By: 

Akira Uehara  
President  
Taisho Pharmaceutical Company, Limited  
24-1, Takata 3-Chome  
Toshimaku  
Tokyo 170-8833  
Japan